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MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER SELBY, GEVELL V	
			ART UNIT 2622	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/266,253

Applicant(s)

UJIE ET AL.

Examiner

Gevell Selby

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54, 55 and 57-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54, 55, and 57-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 54, 55, and 57-63 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 54, 55, 57, 58, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323.**

Regarding claim 54, Saito et al teaches an image sensing apparatus (camera 10) that judges at least whether said image sensing apparatus is connected to an external device (host computer 30) through a memory card such that the operations of the image sensing apparatus, including image capture, are controlled by the external device (host computer 30), which reads on an external control state in which said apparatus is controlled by an external controller unit that can instruct said image sensing apparatus with a plurality of operations including an image sensing operation and a non-image sensing operation (col. 9, line 47-col. 10, line 3).

The determination device is inherently taught because the camera judges whether the camera is in normal mode or remote mode according to whether the flag is set or not (see column 9, lines 49-54).

Saito also teaches that the image sensing apparatus can capture images when its shutter release button is pressed, which reads on an image sensing state in which said apparatus is not controlled by the external controller unit, individually (col. 9, lines 4-7). Therefore, Saito teaches that operations of the camera may be controlled individually or by an external device (see column 9, line 63 to column 10, line 3), which reads on determination of operations of the image sensing apparatus in accordance with whether the image sensing apparatus is controlled by an external device.

In another embodiment, Saito discloses a driving device (see figure 11, element 236) configured to selectively move an image sensing optical system (see figure 11, element 231 and column 13, lines 33-39). The Saito reference also discloses the system controller or determination device determines an operation of said driving device in accordance with a judgment result of said determination device, by detecting the operation of the zoom lever (236) after it is implied the system controller or determining device has already determined the camera is in the normal mode by the flag, the system controller then begins to drive or optically zoom the zoom lens (231) in accordance with the judgment result that the device is in an image sensing state in which said apparatus is not controlled by the external controller unit (see column 13, lines 33-38). The Saito reference further discloses the system controller or determination device determines an operation of said driving device in accordance with a judgment result of said

Art Unit: 2622

determination device that the device is in an image sensing state in which said apparatus is controlled by the external controller, wherein it is implied the system controller or determining device has already determined the camera is in the external mode by the flag before the host computer sends a zoom command to the determination device to drive to the lens (see column 9, line 66 to column 10, line 3). Therefore, Saito reference discloses the determine determination device also determining an operation of said driving device in accordance with a judgment result of said determination device in two of the three states, an image sensing state and the external controller state.

Saito also discloses a liquid crystal display (232) and LCD driving circuit (233) which can display in a playback mode the real-time image and can also display the still images which are recorded in the image to confirm a photographing (see column 13, lines 14-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have been motivated to modify the first embodiment of the Saito reference in view of the fifth embodiment to have a driving device and a playback mode in which said apparatus is not controlled by the external controller unit, in order to focus the image and view the image during photographing, so that the user instantly verify the image was captured correctly, making the photographing process easier while saving the user time not having to connect to the host computer. The system control determining that the camera is in normal mode and displaying the images on the LCD reads on the determining device judging whether said apparatus is in a playback state in which said apparatus is not controlled by the external controller unit.

The Saito reference does not teach that the driving device moves an image sensing optical system to an image sensing region and a non-image sensing region and wherein said determination device causes said driving device to move the image sensing optical system to the non image sensing region based on a judgment that said image sensing apparatus is released the image sensing operation of the first state by functionally disconnecting from the external unit.

Kobayashi teaches a driving device (zoom motor 10) that moves an image sensing optical system (zoom lens 11) to image sensing and non-image sensing regions (col. 9, lines 13-18, 43-49). The Kobayashi reference discloses the camera has several modes including a lock mode (see column 10, lines 15-20), when the determination device or controller determines the camera is in the lock mode, the lens is moved to a non-image sensing or storage region (see column 16, lines 38-50). When the control determines the camera is in marco mode, it moves the lens to an image sensing region (see column 16, lines 53-67). The Kobayashi reference discloses a camera with photographing modes and a lock mode that are set by a main switch 30 and when the main switch is not set to a photographing mode it is set to the lock mode where the lens is set to a non-sensing position (see column 10, lines 17-26).

Shono, US 6,366,323, teaches retracting a lens group into the camera body, when a power switch is turned off.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the driving device of Kobayashi that moves the lens into image sensing and non-image sensing regions into the image sensing

Art Unit: 2622

apparatus that may be controlled individually or by an external device taught by Saito, in order to make an image sensing apparatus that drives its optical system in accordance with the desires of its controller in accordance with the mode of operation, whether the controller is an individual operator or an external unit. It would have been obvious to one of ordinary skill in the art at the time of invention to have been motivated to modify Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and further in view of Shono, US 6,366,323, to move the optical system to the non image sensing region, when the power is turned off, in which the external unit is functionally disconnected from the external unit, in order to make the camera more compact as well as protect the lens. One of ordinary skill would have been motivated to make such a modification to provide greater flexibility in operating a camera. It implied that the combination of Saito and Kobayashi discloses the determination device causing the driving device to move the image sensing optical system to the non image sensing region, based on a judgment that said image sensing apparatus is released from the image sensing operation of a photographing mode including that of the first state by functionally disconnecting from the external unit.

Regarding claims 55, Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, teaches the apparatus of claim 54. Saito teaches that when a camera is connected to the computer, which reads on the external control state, the computer sends controls the camera pertaining to image sensing (col. 9, line 47-col. 10, line 3). It would have been obvious to one of ordinary skill to move the optical system to the image sensing region when capturing images.

Art Unit: 2622

Regarding claim 57, Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, teaches the apparatus of claim 54, respectively. Saito teaches that the host computer transmits shutter release commands to the camera (col. 9, line 47-col. 10, line 3), which reads on an external control state in which the external controller unit transmits an image sensing signal to the camera. It would have been obvious to one of ordinary skill to move the optical system to the image sensing region when capturing images.

Regarding claim 62, Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, teaches the apparatus of claim 54. See above. Kobayashi discloses the image sensing optical system is driven to the non-image sensing region in response to the completion of an image sensing operation in the first state (see Kobayashi: column 16, lines 37-50: When the camera goes into a non-use condition for the lens, the zoom lens is retracted into the camera body).

4. Claims 58-60 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, and further in view of Takahashi, US 5,210,567.

Regarding claim 58, Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, teaches the apparatus of claim 57. See above. Saito, Kobayashi, and Shono do not teach the driving of said optical system to the non-image sensing region in response to a completion of an image sensing operation.

Takahashi teaches the retraction of a lens to a rest position a predetermined time period after an image capture (col. 2, lines 40-52), which reads on the driving of an

Art Unit: 2622

optical system to a non-image sensing region in response to a completion of an image sensing operation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the apparatus of Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and further in view of Shono, US 6,366,323, with the practice of positioning the optical system in the non-image sensing region following the completion of an image capture taught by Takahashi to make an apparatus that retracts the lens once image capture has been completed. One of ordinary skill would have been motivated to make such a modification to protect the lens when not in use.

Regarding claims 59 and 63, Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, teaches the apparatus of claim 57 and 54, respectively. See above. Saito, Kobayashi, and Shono do not teach a timer for causing said driving device to drive said image sensing optical system to the non-image sensing region a predetermined time period after a completion of an image sensing operation.

Takahashi teaches the retraction of a lens to a rest position a predetermined time period after an image capture (col. 2, lines 40-52). The timer is inherently taught.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the apparatus of Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, with the technique of Takahashi to make an image sensing apparatus with a timer that retracts the lens to a non-image sensing position once a predetermined time period following an image capture has elapsed, whether the apparatus is in the external control state or not. One of ordinary skill

Art Unit: 2622

would have been motivated to make such a modification to protect the lens when not in use.

Regarding claim 60, Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, and further in view of Takahashi, US Patent 5,210,567, teaches the apparatus of claims 59. Takahashi teaches the retraction of lens to a rest position after the elapse of a predetermined time period following the last image capture (col. 2, lines 40- 52). It would have been obvious to one of ordinary skill that if another image were captured before the predetermined time period elapses, the timer resets in accordance with the most recent image captured, and the lens would remain in the extended position.

5. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, and further in view of Hashimoto et al, US 6,344,875.

Regarding claims 61, Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, teach the apparatus according to claims 54. See above. Kobayashi teaches that the image sensing optical system is positioned in a non-image sensing region during a non-image sensing state, which reads on the prevention of the optical system from being driven to the image sensing state (col. 16, lines 38-5). Saito teaches a digital camera with a memory for storing digital images (col. 9, lines 13-17). Saito in view of Kobayashi do not teach that the image sensing optical system is in the non-image sensing region when the apparatus is in the external control state.

Art Unit: 2622

Hashimoto teaches that when a computer controls the camera, it is limited to transmitting and receiving images, which reads on non-image sensing states (col. 10, lines 30-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of positioning optical systems in the non-image sensing position when the apparatus is in a non-image sensing mode taught by Saito et al, US 6,256,063, in view of Kobayashi et al, US 5, 136,320, and Shono, US 6,366,323, with the use of external control states taught by Hashimoto to make an apparatus that positions the optical system in the non-image sensing region when the camera is transmitting or receiving images in the external control state. One of ordinary skill would have been motivated to make such a modification to safeguard the lens when it is not in use.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gevell Selby whose telephone number is 571-272-7369. The examiner can normally be reached on 8:00 A.M. - 5:30 PM (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on 571-272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gvs



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